

**PATENT**

Atty Docket No.: 10016512-1

App. Ser. No.: 10/700,065

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks. Claims 1, 2, 6-10, 12-14, 16-23, 38-48 and 51-55 are pending in the present application of which claims 1, 9, 16, 22 and 38 are independent. Claims 3-5, 15, 24-37, and 49-50 are canceled.

Claims 16-21 were rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 and 48 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990).

Claims 6-8 and 16-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990) and further in view of Guzik et al. (2002/0114101).

Claim 49 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990) and further in view of Shu (6,765,748).

**Allowable Subject Matter**

The Examiner is thanked for indicating claims 9, 10, 1-14, 38, 39, 44-47, 54, and 55 are allowed, and for indicating claims 40-43 and 50-53 include allowable subject matter.

**Claim Objection**

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Claim Rejection Under 35 U.S.C. §112

Claims 16-21 were rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, "the timing information" in lines 10-11 of claim 16 allegedly does not have antecedent basis. However, timing information is recited in line 4 of claim 16. Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would

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have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

**Claims 1-2 and 48**

Claims 1-2 and 48 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990).

The features of allowable claim 50 and intervening claim 49 have been combined with claim 1. Accordingly, claims 1-2 and 48 are believed to be allowable.

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**Claims 6-8 and 16-23**

Claims 6-8 and 16-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990) and further in view of Guzik et al. (2002/0114101).

Independent claim 16, recites, "second means for writing second information in the second cluster during a timing window determined from the timing information." The rejection admits Marshall in view of Mizasawa fails to disclose timing windows, but alleges the servo burst of Guzik contains timing information as described in paragraphs 60 and 64. The servo bursts of Guzik are used to measure head positioning error, as disclosed in the last 3 lines of paragraph 64 of Guzik. However, Guzik fails to teach or suggest any timing information or determining a timing a window from the servo bursts. Accordingly, claims 16-21 are believed to be allowable.

Independent claim 22 recites, "a field emitter configured to read information from or write information to the at least one data storage area during a timing window determined from the timing information." As described above, Guzik fails to teach or suggest any timing information or determining a timing a window from the servo bursts. Accordingly, claims 22 and 23 are believed to be allowable.

Claims 6-8 are believed to be allowable at least for the reason claim 1 is believed to be allowable.

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**Claim 49**

Claim 49 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Marshall (2002/0122373) in view of Mizasawa et al. (5,270,990) and further in view of Shu (6,765,748). Claim 49 is canceled herein, and thus the rejection is moot.

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**Conclusion**

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: October 29, 2008

By



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